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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/287,968 03/14/01 OTTO

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EXAMINER

PM82/0622

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PECHHOLD, A

ART UNIT

PAPER NUMBER

3673

DATE MAILED:

06/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/287,968

Applicant(s)

OTTO ET AL.

Examiner

Alexandra K. Pechhold

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2001 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

### **DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 3673.

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference signs not mentioned in the description: "B" and "C" in Fig. 5. Correction is required.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossburger (US 5,395,182).
4. Regarding claims 1 and 20, Rossburger discloses the limitations of the claimed invention except for a plurality of walking beams, and the number of rear roller members being the same as the number of front roller members. Rossburger discloses a roller assembly comprising a frame member, seen as frame (1) in Fig. 4. A plurality of front roller members and rear roller members are depicted as wheels (75) in Fig. 1. A

Art Unit: 3673

walking beam, seen as pivot arm beam (40) is pivotably connected to top plate (30), which is connected to frame (1) (Col 2, lines 51-54 and Fig. 1). The beam (40) connects the rear wheels to the front wheels, as illustrated in Fig. 1. The roller compacting apparatus of Rossburger is connected to a towing vehicle (Col 1, lines 31-33 and Col 2, lines 22-24). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the number of front and rear wheels of Rossburger to be the same, since finding the optimum number of wheels is a design choice dependent on the size of the wheels and environmental conditions such as the width of the road to be compacted. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the single pivot arm beam of Rossburger to include a plurality of pivot arm beams, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 13, Rossburger discloses the limitations of the claimed invention except for exactly five front roller members, five rear roller members, and five walking beams. Rossburger discloses the limitations of the claimed invention as discussed in reference to claim 1 above. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the number of front and rear wheels of Rossburger to comprise five, since finding the optimum number of wheels is a design choice dependent on the size of the wheels and environmental conditions such as the width of the road to be compacted. It would also have been obvious to one having ordinary skill in the art at the time the invention was made to modify the single

pivot arm beam of Rossburger to comprise five pivot arm beams, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 2 and 14, Rossburger illustrates in Fig. 1 the radial axes of the front roller members being offset from the radial axes of the rear roller members.

Regarding claim 3, Rossburger illustrates frame (1) in Fig. 4, comprising a rectangular outer frame since the frame is formed by a pair of end plates (3, 5) interconnected by tubular metal crossbars (6, 7, 8) (Col 2, lines 6-13).

Regarding claim 4, Rossburger discloses that frame (1) is defined by tubular metal crossbars (6, 7, 8) (Col 2, lines 12-13). Rossburger fails to disclose that the metal is steel. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the metal of Rossburger to be steel, since steel is known to provide strength, and furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 5 and 15, Rossburger discloses an attachment mechanism, seen as support plates (16) in Fig. 1 fixedly connected to the towing vehicle, usually a grader (not shown) (Col 2, lines 18-24).

Regarding claims 6, 7, 16, and 17, Rossburger discloses the limitations of the claimed invention except for a hitch mechanism secured on the opposite side of the frame member as the attachment mechanism. Rossburger discloses an attachment mechanism, seen as support plates (16) extending from the frame (1) for attachment to

a towing vehicle (Col 2, lines 18-24). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Rossburger to include a hitch mechanism secured to the opposite side of the frame as the support plates, since Rossburger already discloses the connection of the road compacting apparatus to a towing vehicle in column 1, lines 31-33, therefore indicating the ability to connect to a vehicle. Furthermore, by providing another connecting means to the road compacting apparatus, the existing attachment member is merely duplicated on the opposite side of the frame. It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 8, Rossburger discloses tire and wheel assemblies, seen as wheels (75) in Figs. 1-3.

Regarding claim 9, Rossburger discloses lubricated bushings, seen as roller bearings (73) in Fig. 6 (Col 3, lines 21-23).

Regarding claim 10, Rossburger discloses at least one reinforcing beam secured to the frame member, see as bar (33) or bar (26) in Fig. 4.

Regarding claims 11 and 19, Rossburger discloses a pair of parallel reinforcing beams secured at a central portion of the frame member, depicted as bar (33) and bar (26) in Fig. 4.

Regarding claim 12, Rossburger illustrates at least one of the wheels (75) mounted between the bar (33) and bar (26) in Figs. 1 and 4.

Regarding claim 18, Rossburger discloses the limitations of the claimed invention as discussed in reference to claims 8 and 9 above.

**Conclusion**

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Porter (US 2,624,251) discloses an apparatus for earth compaction. Schneider (US 3,401,611) discloses an apparatus and method for repair of pavement. Smith (US 2,407,965) discloses a roller. Freeman (US 4,909,663) discloses a road making apparatus. Almer (US 6,119,792) discloses a land smoother and packer system. Cox et al (US 3,993,413) discloses a road packer. Stolp (US 3,291,013) discloses a wheeled compactor.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexandra Pechhold whose telephone number is (703) 305-0870. The examiner can normally be reached on Mon-Thurs. from 8:00am to 5:30pm and alternating Fridays from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas B. Will, can be reached on (703)308-3870. The fax phone number for this Group is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.



**Thomas B. Will**  
**Supervisory Patent Examiner**  
**Group 3600**